REMARKS

Reconsideration and continued examination of this application are respectfully requested.

The amendment to the specification corrects an inadvertent error regarding the §120 data claimed by the applicants. No new matter has been added. The claim under §120 is proper and correct as shown. The previous amendment inadvertently added a patent number to the wrong version of this paragraph. The information now set forth in the amendment is correct. No questions of new matter should arise and entry of this amendment is respectfully requested.

At page 2 of the Office Action, the Examiner rejects claims 95-117 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner, for the most part, provides the same reasoning for rejecting the claimed invention under 35 U.S.C. §112, first paragraph, as in the previous Office Action dated December 26, 2002. Additionally, the Examiner asserts that the application does not provide any description regarding "wherein the aggregate has silanol groups located at the surface of the aggregate." The Examiner also asserts that the application does not provide any guidance on how to test that the aggregate includes silanol groups on its surface. The Examiner then concludes that there is a burden of undue experimentation to make, characterize, or identify the material as claimed. For the following reasons, this rejection is respectfully traversed.

As stated in the Amendment dated March 25, 2003, a silanol group at the surface of the aggregate is an inherent property in the examples of the present application for the aggregate comprising a carbon phase and a silicon-containing species phase. The presence of silanol groups on an aggregate having a carbon phase and a silicon-containing species phase is clearly described for instance in the paper entitled "Carbon-Silica Dual Phase Filler, Part IV Surface Chemistry," by Murphy et al., which is enclosed as attachment A-1. A method to measure the silanol concentration at the surface of carbon-silica dual phase filler is described in Murphy et al. According to Murphy et al., when trimethylchlorosilane (TMCS) is added to an aggregate comprising a carbon phase and a silicon-containing species phase, the TMCS reacts with the silanol groups on the silica phase at the surface. The TMCS uptake is measured, which shows the silanol concentration at the surface of the aggregate. Murphy et al. clearly describes how to test for silanol concentration at the surface of the aggregate. This article further shows that the aggregates of the present invention, in at least certain embodiments, have silanols on the surface.

Furthermore, the Examiner further asserts that if the presence of silanol groups located at the surface of an aggregate is inherent within certain embodiments of the claimed invention, then the claimed invention is rejected under statutory double patenting and rejected under the judicially created doctrine of obviousness type double patenting in view of claims 1-22 of U.S. Patent No. 6,057,387. By taking this position, the Examiner himself acknowledges that the presence of silanol groups on the surface of an aggregate is inherent with at least some embodiments. Accordingly, this rejection should be withdrawn.

At page 3 of the Office Action, the Examiner asserts that the applicants have not complied with one or more conditions for receiving the benefit of an earlier filing date under

35 U.S.C. §120. According to the Examiner, the application repeats a substantial portion of prior U.S. Patent Application No. 09/453,419, filed December 2, 1999. The Examiner further asserts that since U.S. Patent Application No. 09/453,419 names an inventor or inventors in the prior application, it may constitute a continuation-in-part of the prior application. For the following reasons, the applicants should receive the benefit of the filing date of the prior application.

With respect to the Examiner's comment regarding receiving the benefit of an earlier filing date under 35 U.S.C. §120, the specification, by amendment made herewith, states that the application is a continuation of U.S. Patent Application No. 09/453,419, filed December 2, 1999, now U.S. Patent No. 6,364,944, which is a continuation of U.S. Patent Application No. 09/375,044, filed August 16, 1999, now U.S. Patent No. 6,211,279, which is a divisional of U.S. Patent Application No. 09/061,871, filed April 17, 1998, now U.S. Patent No. 6,057,387, which is a continuation-in-part of U.S. Patent Application No. 08/837,493, filed April 18, 1997, now U.S. Patent No. 5,904,762. As stated above, and apparently appreciated by the Examiner, an inadvertent error was made in correcting the §120 paragraph in the previous amendment. Essentially, the wrong version of the §120 paragraph was revised and this is equally apparent since the then-pending §120 paragraph was not amended. To avoid any further confusion, the §120 paragraph as present in the preliminary amendment is re-inserted with minor editorial changes. Accordingly, the applicants are entitled to the benefit of the earlier filing date under 35 U.S.C. §120.

At page 4 of the Office Action, the Examiner indicates that claims 59-81 are allowed. The applicants and the undersigned are appreciative of the indication of allowable subject matter and believe that the comments set forth above should convince the Examiner

that the balance of the pending claims are in a condition for allowance as well.

At page 5 of the Office Action, the Examiner rejects claims 95-117 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,057,387. The Examiner asserts that although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the claims is inherent to the material of the issued patent. For the following reasons, this rejection is respectfully traversed.

While the applicants do not necessarily agree with the rejection, in order to further the prosecution of this application, a terminal disclaimer is submitted herewith. Accordingly, this rejection should be withdrawn.

At page 6 of the Office Action, the Examiner also rejects claims 95-117 under 35 U.S.C. §101 as claiming the same invention as that of claims 1-22 of U.S. Patent No. 6,057,387. According to the Examiner, the difference between the claims is inherent to the material of the issued patent and such material appears to be identical. For the following reasons, this rejection is respectfully traversed.

Statutory double patenting requires the claimed invention and the reference to be drawn to identical subject matter. Claim 95 of the present application recites, in part, wherein the aggregate has silanol groups located at the surface of the aggregate. However, no such language exists in the claims of U.S. Patent No. 6,057,387. The claims of the present application require silanol groups, while the claims of the '387 patent do not. The claims are clearly not identical. Furthermore, the Examiner acknowledges at page 5 of the Office Action, that "the conflicting claims are not identical." Accordingly, the statutory double patenting rejection should be withdrawn.

At page 6 of the Office Action, the Examiner replies to the applicants' arguments set forth in the Amendment dated March 25, 2003. With respect to the document provided by the applicants, which provides test data showing the presence of the silanol groups on surface of an aggregate, the Examiner did not find the test convincing because the information did not constitute extrinsic evidence. However, the Examiner does not provide any technical arguments as to why the document providing the test data showing the presence of silanol groups on surface of an aggregate submitted with the Amendment dated March 25, 2003 is not applicable. Therefore, the Examiner's argument is conclusory. Further, the attached article clearly supports the applicant's position.

The Examiner also states that the objections to the abstract and the designation "N234 carbon black" have been withdrawn. The applicants and the undersigned are appreciative of the Examiner's indication that the abstract and the designation N234 carbon black are acceptable.

At page 7 of the Office Action, the Examiner also states that in the Information Disclosure Statement, citations of non-English language have been lined through as they could not be considered. With respect to non-U.S. reference, according to a computer search, please note that FR 1,230,893 is equivalent to U.S. Patent No. 3,025,259; EP 675,175 is equivalent to U.S. Patent No. 5,827,361; DE 1,948,443 is equivalent to U.S. Patent No. 3,660,132; DE 3,813,678 A1 is equivalent to U.S. Patent No. 4,820,751; and EP 0799,866 A2 is equivalent to U.S. Patent No. 5,859,120. Furthermore, enclosed is a copy of English translated abstracts of DE 3,502,494 and DE 2,403,545. Furthermore, the Examiner has lined through the International Search Reports (ISR) listed on page 5 of the Information Disclosure Statement. Clearly, the ISR can be understood and considered by the Examiner.

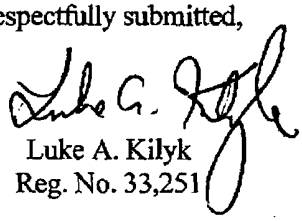
Accordingly, the applicants respectfully request reconsideration of the references not previously considered by the Examiner.

CONCLUSION

In view of the foregoing remarks, the applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

If there are any other fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 03-0060. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such extension is requested and should also be charged to said Deposit Account.

Respectfully submitted,



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